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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

NGHIEM, MICHAEL P

ART UNIT	PAPER NUMBER
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2863

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,054

Applicant(s)

ECKARD ET AL.

Examiner

Michael P Nghiem

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-9, 12, 14-16, 19-22, 25, 27 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8, 14-16, 19, 20, 22, 27 and 30-33 is/are allowed.
- 6) ☒ Claim(s) 9, 12, 21 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Communication filed on December 22, 2003 has been acknowledged.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Garcia et al. (US 6,042,216).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Art Unit: 2863

Garcia et al. discloses all the claimed features of the invention including:

- a method and system (via 230, Fig. 14's) for servicing an inkjet printer (Figs. 1, 16)

including an inkjet printhead (106) with a nozzle plate (Fig. 4) and a first service module (wiper 234 or capper 236) removably installed on the printer (Fig. 23), comprising:

- identifying a printhead-related service condition (Abstract, lines 3-6) not adequately addressed by servicing the printer with the first service module being in an un-worn condition (complete servicing includes other service module such as a capper, a spittoon, and primer connection, Abstract, lines 6-8);

- providing a second service module (capper 236 or wiper 234) with a service function different from the first service module (Fig. 14a) and adapted to address said printhead-related service condition, the second service module removably installable on the printer and with respect to the first service module (Fig. 23);

- providing the second service module to the printer user (234, 236 is available for use, Fig. 23), wherein the step of providing a set of instructions includes providing a set of human-readable instructions for using the second service module (column 6, line 61 - column 7, line 7, column 8 line 7-18 provide human-readable instructions on how to use the second service module 234, 236).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2863

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia et al. in view of Wojcik (US 6,250,736).

Garcia et al. does not disclose that the second service module includes a wiper fabricated of silicon, or a textile, or a special rubber for removing the ink accumulation.

Nevertheless, Wojcik discloses a wiper (26) fabricated of silicon or rubber for removing the ink accumulation (column 3, lines 5-11) for the purpose of providing a compliant and durable wiper.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Garcia et al. with a silicon or rubber wiper as disclosed by Wojcik for the purpose of providing a compliant and durable wiper.

Allowable Subject Matter

3. Claims 5-8, 14-16, 19, 20, 22, 27, and 30-33 are allowed.

Reasons For Allowance

4. The method or combination as claimed wherein removing the first service module from the printer and installing the second service module in the printer in place of the first service module (claim 5, 22, 30, 31) or providing a set of machine readable printer instruction code (claims 7, 19) or said printhead-related service condition includes ink on a printhead carriage interconnect, and the second service module includes a brush arranged to clean the interconnect (claims 14, 27) or the second service module includes a special capping structure having a range of movement along an axis generally transverse to a nozzle array of the printhead (claims 15, 32) is not disclosed, suggested, or made obvious by the prior art of record.

Response to Arguments

5. Applicant's arguments filed on December 22, 2003 have been fully considered but they are not persuasive.

With respect to the 35 USC 102 rejections, Applicants disagrees with the Examiner's recitation of the teachings of Garcia:

1. The Examiner reads wiper (234) or capper (236) as corresponding to a first service module.

Examiner's position is that either wiper (234) or capper (236) services the printhead (Abstract, lines 3-8).

2. The Examiner asserts that Garcia discloses "identifying a printhead-related service condition not adequately addressed by servicing the printer with the first service module being in an un-worn condition"

Examiner's position is that Garcia discloses that a complete printhead related servicing would include services performed by a capper, wiper, spittoon, and primer connection (Abstract, lines 6-8). A printhead, right after being serviced by, e.g., a wiper, would be in a service condition wherein it has not been serviced by a capper.

3. Applicants further argue that there is no teaching or description in Garcia that a wiper (234) is removably installable with respect to a capper (236).

Examiner's position is that Fig. 23 of Garcia shows that the wiper (234) is removable with respect to the capper (236) by removing the lid (380). Further, the capper (236) is removable with respect to the wiper (234) by removing a screw (see Fig. 14a).

4. Applicants argue that there is no showing in Garcia that the alleged instructions are provided to the printer use, i.e., the Garcia document is provided to the printer user.

Examiner's position is that the disclosure of an invention in a US Patent (including Garcia) is intended for one of ordinary skill in the art to make use of the invention.

Under 35 USC 112, first paragraph, the "specification shall contain a written description

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of the invention, and of the manner and process of making and **using it**, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and **use the same** and shall set forth the best mode contemplated by the inventor of carrying out his invention”.

Applicants further argue that there is no description of how the user can or should use a “module” (234) or (236).

Examiner’s position is that part of how to use the wiper (234) or capper (236) is how to install/remove them. Fig. 23 shows how to install/remove the wiper (234) and capper (236).

Thus, the limitations of claims 9 and 21 are disclosed by Garcia as discussed above.

With respect to the 35 USC 103 rejections of claims 12 and 25, Applicants argue that Garcia does not address the problem of a printhead-related service condition not adequately addressed by servicing the first module being in an un-worn condition. Examiner’s position has been addressed above (with respect Applicants’ arguments regarding the 35 USC 102 rejections).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

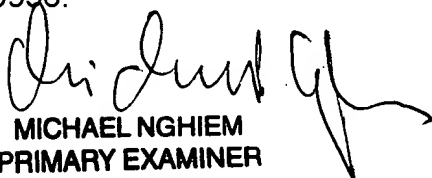
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2272. The examiner can normally be reached on M-H from 6:30AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached at (571) 272-2269. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


MICHAEL NGHIEM
PRIMARY EXAMINER

Michael Nghiem

March 15, 2004